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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/760,214

01/21/2004

Kia Silverbrook

WAL15US

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

GOLDBERG, BRIAN J

ART UNIT

PAPER NUMBER

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DELIVERY MODE

06/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/760,214	Applicant(s) SILVERBROOK ET AL.	
	Examiner Brian J. Goldberg	Art Unit 2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,9,21-30 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,9,21-30 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/112,767.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/18/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/18/08 has been entered.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

3. Regarding claim 1, for an application to make a proper claim for priority, it must contain a reference or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate. This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing

date of the prior-filed application (see Rule 1.78 of the MPEP). In the instant application, reference was appropriately made on 1/21/04 to prior-filed application 10/160,273 filed on 6/4/02. However, reference to prior-filed application 09/112,767 (the grandparent) was not made until 4/20/06, which exceeds the time period set forth for such a claim (as cited above). Therefore, claim 1 of the instant application has only been granted the priority date of 6/4/02 as its effective filing date.

4. Furthermore, regarding claims 2-4, 9, 21-30, and 45, the examiner has repeatedly stated that there has been no support found for these claims in the parent application, and thus these claims are not given priority to the parent in the instant continuation-in-part application. When determining the effective filing date, if the application is a continuation-in-part of an earlier U.S. application or international application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application (see MPEP 706.02 VI.(B)). However, to reiterate, claims 2-4, 9, 21-30, and 45 do not meet this standard as stated in the previous rejection: The disclosure of the prior-filed application, Application No. 10/160273, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior-filed application does not appear to provide adequate support for any of the subject matter claimed in claims 2-4, 9, 21-30, and 45 and these claims therefore do not gain the benefit of the earlier filing date.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US 5051761) in view of Silverbrook (US 6322195) and further in view of Lin et al. (US 6022104).

7. Regarding claim 1, Fisher et al. disclose “a printhead assembly for a printer which prints onto a moving web (12 of Fig 1) that follows a path, comprising: a full width printhead (34 of Fig 1 and col 4 ln 15-18) located across the path...the color printhead being supplied with a number of different colored inks (31M/Y/C/B of Fig 1).” Thus Fisher et al. meet the claimed invention except “the printhead comprising a plurality of inkjet nozzles having thermal bend actuators configured to cause ink ejection from the nozzles; the printhead comprising a color printhead which is at least as wide as the web.”

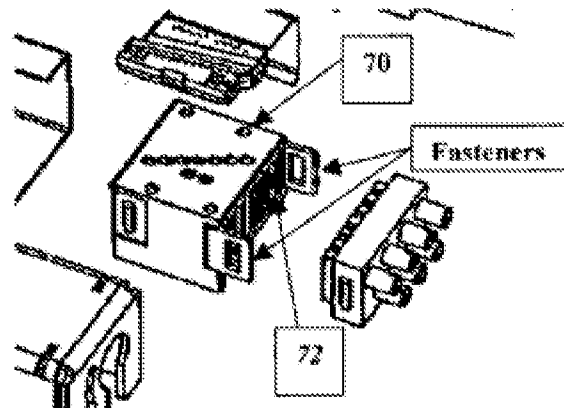
8. Silverbrook teaches “the printhead comprising a plurality of inkjet nozzles (4 of Fig 1) having thermal bend actuators (7 of Fig 1), each thermal bend actuator having an arm (10 of Fig 1) comprising a heater portion (11 of Fig 1), each heater portion being configured to thermally expand upon heating thereby bending the associated arm so as to cause ink ejection from the nozzles (col 4 ln 49-57, see Figs 1-10).” It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to

include inkjet nozzles with thermal bend actuators. One would have been motivated to so modify Fisher et al. for the benefit of permitting high speed printing and increasing the ejection efficiency.

9. Lin et al. teach “the printhead comprising a color printhead (170 of Fig 2) which is at least as wide as the web (P of Fig 2).” It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to make the color printhead at least as wide as the web. One would have been motivated to so modify Fisher et al. in view of Silverbrook for the benefit of enabling printing on the entire web if small margins or margin-less printing is desired.

1. Claims 2-4, 9, and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. in view of Silverbrook and Lin et al. and further in view of Silverbrook (US 20020180834). Fisher et al. in view of Silverbrook and Lin et al. disclose the claimed invention as set forth above regarding claim 1. Thus, Fisher et al. in view of Silverbrook and Lin et al. meet the claimed invention except the limitations set forth in claims 2-4, 9, and 21-30.

2. Regarding claims 2-4, and 9, Silverbrook teaches “a rail which is located across the path and along which the printhead slides into and out of a printing position (Par [0057], [0013], [0014])...the printhead is secured to the rail by fasteners which allow the printhead to be removed when the fasteners are disengaged (Par [0057] and see Fig 8 below)...”



“...the inks are contained in individual reservoirs and a supply tube connects each reservoir to the printhead (Par [0057] and [0059])...a coupling in each ink supply tube which can be disconnected so that the printhead can be withdrawn (Par [0059]).” It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include a rail with the printhead secured to it by fasteners and having a supply tube capable of being disconnected supply ink to the printhead from reservoirs. One would have been motivated to so modify Fisher et al. in view of Silverbrook and Lin et al. for the benefit of allowing the printhead to be repaired or replaced, and thus extending the life of the printer.

3. Regarding claims 21-23, the printing rate does not substantially further limit the structure of the printhead assembly and the rates could be reached through routine experimentation for optimization since such experimentation would result in acquiring the best possible quality. Also, even if one argues that it does further limit the structure, the various printing rates are disclosed by Silverbrook (see chart at the bottom of page 9 where the printing rate exceeds 7750 square feet per hour).

4. Regarding claims 24-30, Silverbrook discloses the various number of nozzles claimed (see Par [0093] where 552960 nozzles are disclosed) and the various volumes for the ink drops (see Par [0095] where 1 picoliter is disclosed). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Fisher et al. in view of Silverbrook and Lin et al. to have the various numbers of nozzles and the various volumes for the ink drops in order to achieve the predictable result of high speed and accurate printing.

5. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. in view of Silverbrook and Lin et al. and further in view of Silverbrook and Martin (20020171692). Fisher et al. in view of Silverbrook and Lin et al. disclose the claimed invention as set forth above regarding claim 1. Thus Fisher et al. in view of Silverbrook and Lin et al. meet the claimed invention except for the limitations set forth in claim 45.

6. Silverbrook teaches "the printhead being supplied by separate ink reservoirs, the reservoirs connected to the printhead by an ink supply harness, there being a disconnect coupling between the reservoirs and the printhead (Par [0057] and [0059])." It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to supply the printhead with ink from detachable ink reservoirs. One would have been motivated to so modify Fisher et al. in view of Silverbrook and Lin et al. for the benefit of allowing the printhead or ink reservoirs to be refilled or replaced, thus extending the life of the printer.

10. Martin teaches "a housing in which is located a media path which extends from a blank media intake to a wallpaper exit slot (see Fig 2 with media 27, enters from supply

24, exits to take-up 26); a multi-color roll width removable printhead located in the housing and across the media path (20 of Fig 2, see Par [0009]); one or more input devices for capturing operator instructions (36, 37 of Fig 2); a processor which accepts operator inputs which are used to configure the printer for producing a particular roll (38 of Fig 2, Par [0009] and [0010]).” It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the housing, input devices, and processor disclosed by Martin with the printhead assembly disclosed by Fisher et al. in view of Silverbrook, Lin et al. and Silverbrook. One would have been motivated to so modify Fisher et al. in view of Silverbrook, Lin et al. and Silverbrook for the benefit of allowing the user to personalize the media by arranging the printed images in a pattern, as stated by Martin.

Response to Arguments

11. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments with respect to claims 2-4, 9, 21-30, and 45 have been fully considered but they are not persuasive. As discussed above, these claims do not meet the requirements to gain the effective filing date of the parent application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Goldberg whose telephone number is (571)272-2728. The examiner can normally be reached on Monday through Friday, 9AM-5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Luu can be reached on 571-272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LUU MATTHEW/
Supervisory Patent Examiner, Art Unit 2861

/Brian J. Goldberg/
Examiner
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